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Paper No.

ELAN DRUG DELIVERY, INC.
C/O FOLEY & LARDNER LLP
3000 K STREET, N.W.
SUITE 500
WASHINGTON DC 20007-5109

MAILED

MAR 29 2010

OFFICE OF PETITIONS

In re Application of	:	
Rajeev A. Jain, Jon Swanson,	:	
Robert Hontz, John Devane,	:	
Jenneth Iain Cumming, Maurice	:	
Joseph Anthony Clancy, and	:	
Janet Elizabeth Codd	:	DECISION ON TWO SECOND
Application No. 09/337,675	:	RENEWED PETITIONS PURSUANT
Filing Date: June 22, 1999	:	TO 37 C.F.R. §§ 1.48 AND
Attorney Docket Number:	:	1.183
029318/0497	:	
Title: CONTROLLED-RELEASE	:	
NANOPARTICULATE COMPOSITIONS	:	

This is a decision on the two second renewed petitions pursuant to 37 C.F.R. §§ 1.48 and 1.183, concurrently filed on March 11, 2010. Petitioner has requested the correction of the inventorship of the present application, along with the waiver of 37 C.F.R. § 1.48(a)(3).

The renewed petition pursuant to 37 C.F.R. § 1.48(a)(3) is **GRANTED**.

The renewed petition pursuant to 37 C.F.R. § 1.183 is **DISMISSED AS MOOT**.

Two petitions pursuant to 37 C.F.R. §§ 1.48 and 1.183 were concurrently filed on July 3, 2008. The former was supplemented via a submission on July 17, 2008. Petitioner provided, *inter alia*, the required petition fees, the written consent of the assignee coupled with a statement pursuant to 37 C.F.R.

§ 3.73(b), a statement from the person being added as an inventor that the error in inventorship occurred without deceptive intention on his part, a Supplemental Application Data Sheet (ADS), and a declaration that has been executed by each inventor save Mr. Cumming.

Both petitions were dismissed via the mailing of a single decision on March 30, 2009.

Two renewed petitions pursuant to 37 C.F.R. §§ 1.48 and 1.183 were concurrently filed on April 15, 2009. Each was dismissed via the mailing of a single decision on February 16, 2010.

With these second renewed petitions, Petitioner has submitted a declaration that has been executed by formerly non-signing joint inventor Cumming.

A corrected filing receipt has been included with this decision.

The Technology Center will be notified of this decision, and jurisdiction over this application is transferred to the Technology Center, so that the application may receive further processing. The Technology Center's support staff will notify the Examiner of this decision, so that the present application can receive further processing in due course.

Telephone inquiries regarding *this decision* should be directed to the undersigned at (571) 272-3225.¹ All other inquiries concerning examination procedures or status of the application should be directed to the Technology Center.

/Paul Shanoski/
Paul Shanoski
Senior Attorney
Office of Petitions

Encl. corrected filing receipt

¹ Petitioner will note that all practice before the Office should be in writing, and the action of the Office will be based exclusively on the written record in the Office. See 37 C.F.R. § 1.2. As such, Petitioner is reminded that no telephone discussion may be controlling or considered authority for Petitioner's further action(s).



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UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NUMBER	FILING or 371(c) DATE	GRP ART UNIT	FIL FEE REC'D	ATTY. DOCKET NO	TOT CLAIMS	IND CLAIMS
09/337,675	06/22/1999	1615	2006	029318/0497	35	3

CONFIRMATION NO. 9275

CORRECTED FILING RECEIPT



0000000040825002

31049

Elan Drug Delivery, Inc. c/o Foley & Lardner
3000 K Street, N.W.
Suite 500
Washington, DC 20007-5109

Date Mailed: 03/29/2010

Receipt is acknowledged of a CPA in this non-provisional patent application. The application will be taken up for examination in due course. Applicant will be notified as to the results of the examination. Any correspondence concerning the application must include the following identification information: the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. **If an error is noted on this Filing Receipt, please submit a written request for a Filing Receipt Correction. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections**

Applicant(s)

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Domestic Priority data as claimed by applicant

Foreign Applications

If Required, Foreign Filing License Granted: 07/20/1999

The country code and number of your priority application, to be used for filing abroad under the Paris Convention, is **US 09/337,675**

CPA Filed on: 02/28/2001

Projected Publication Date: Not Applicable

Non-Publication Request: No

Early Publication Request: No
Title

CONTROLLED-RELEASE NANOPARTICULATE COMPOSITIONS

Preliminary Class

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PROTECTING YOUR INVENTION OUTSIDE THE UNITED STATES

Since the rights granted by a U.S. patent extend only throughout the territory of the United States and have no effect in a foreign country, an inventor who wishes patent protection in another country must apply for a patent in a specific country or in regional patent offices. Applicants may wish to consider the filing of an international application under the Patent Cooperation Treaty (PCT). An international (PCT) application generally has the same effect as a regular national patent application in each PCT-member country. The PCT process **simplifies** the filing of patent applications on the same invention in member countries, but **does not result** in a grant of "an international patent" and does not eliminate the need of applicants to file additional documents and fees in countries where patent protection is desired.

Almost every country has its own patent law, and a person desiring a patent in a particular country must make an application for patent in that country in accordance with its particular laws. Since the laws of many countries differ in various respects from the patent law of the United States, applicants are advised to seek guidance from specific foreign countries to ensure that patent rights are not lost prematurely.

Applicants also are advised that in the case of inventions made in the United States, the Director of the USPTO must issue a license before applicants can apply for a patent in a foreign country. The filing of a U.S. patent application serves as a request for a foreign filing license. The application's filing receipt contains further information and guidance as to the status of applicant's license for foreign filing.

Applicants may wish to consult the USPTO booklet, "General Information Concerning Patents" (specifically, the section entitled "Treaties and Foreign Patents") for more information on timeframes and deadlines for filing foreign patent applications. The guide is available either by contacting the USPTO Contact Center at 800-786-9199, or it can be viewed on the USPTO website at <http://www.uspto.gov/web/offices/pac/doc/general/index.html>.

For information on preventing theft of your intellectual property (patents, trademarks and copyrights), you may wish to consult the U.S. Government website, <http://www.stopfakes.gov>. Part of a Department of Commerce initiative, this website includes self-help "toolkits" giving innovators guidance on how to protect intellectual property in specific countries such as China, Korea and Mexico. For questions regarding patent enforcement issues, applicants may call the U.S. Government hotline at 1-866-999-HALT (1-866-999-4158).

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Title 35, United States Code, Section 184
Title 37, Code of Federal Regulations, 5.11 & 5.15

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